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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,541	12/11/2001	Sumita B. Mitra	56946US002	7898

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,541	MITRA ET AL.	
	Examiner	Art Unit	
	Jessica L. Rossi	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/21/04, Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37 is/are pending in the application.
- 4a) Of the above claim(s) 19-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/4/04, 6/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 6/21/04. Claims 1-37 are pending, but claims 19-37 were withdrawn from further consideration (see paragraph 3 below). Please note Applicant used wrong status identifier for claim 1 – should be “currently amended” and not “original.” If Applicant presents claim 1 in a subsequent response without further amending, please use the “previously presented” status identifier.

2. The double patenting objection set forth in paragraph 19 of the previous office action dated 2/19/04 has been withdrawn in light of Applicant’s arguments found on p. 17 of the present response.

Election/Restrictions

3. Applicant's election with traverse of Group I, claims 1-18, in the reply filed on 6/21/04 is acknowledged. The traversal is on the ground(s) that all the claims can be evaluated in one search without placing undue burden on the examiner. This is not found persuasive because the inventions of Groups I-III are distinct for the reasons set forth in paragraphs 2-4 of the previous office action, thereby placing serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-16 and 18 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (US 5240761; of record) in view of the collective teachings of Ochi (US 4556595;

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of record), Merrill et al. (US 3857731; of record), Gochanour (US 5774889; of record), and Hibler (US 6493879; of record), as set forth in paragraph 9 of the previous office action.

6. Claims 15-17 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. and the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler as applied to claim 1 above, and further in view of Kaltman et al. (US 5711026; of record), as set forth in paragraph 10 of the previous office action.

7. Claims 1-4 and 6-14 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Gochanour in view of Calhoun et al., as set forth in paragraph 11 of the previous office action.

8. Claims 1-3, 5-6, 8-10, 13-16, and 18 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Hibler in view of Calhoun et al., as set forth in paragraph 13 of the previous office action.

9. Claim 4 **stands** rejected under 35 U.S.C. 103(a) as being unpatentable over Hibler and Calhoun et al. as applied to claim 1 above, and further in view of Loewer et al. (US 6256788; of record), as set forth in paragraph 14 of the previous office action.

10. Claims 7 and 11-12 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Hibler and Calhoun et al. as applied to claim 1 above, and further in view of Gochanour, as set forth in paragraph 15 of the previous office action.

11. Claims 1-3, 6, 8-10, and 15-17 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltman et al. in view of Calhoun et al., as set forth in paragraph 16 of the previous office action.

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12. Claims 4, 7, and 11-12 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltman et al. and Calhoun et al. as applied to claim 1 above, and further in view of Gochanour, as set forth in paragraph 17 of the previous office action.

13. Claim 18 **stands** rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltman et al. and Calhoun et al. as applied to claim 1 above, and further in view of Hibler, as set forth in paragraph 18 of the previous office action.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-16 and 18 **stand** provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16, 18-35, 37-50, and 52-58 of copending Application No. 10/016544 in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler and also in view of Calhoun et al., as set forth in paragraph 21 of the previous office action.

This is a provisional obviousness-type double patenting rejection.

16. Claim 17 **stands** provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16, 18-35, 37-50,

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and 52-58 of copending Application No. 10/016544 in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler and also in view of Calhoun et al., and further in view of Kaltman et al., as set forth in paragraph 22 of the previous office action.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

17. Applicant's arguments filed 6/21/04 have been fully considered but they are not persuasive.

18. On page 11 of the arguments, Applicant argues that Calhoun teaches all the limitations in present claim 1 except the sheet material providing temporary surface protection or surface modification.

The examiner points out that the repositionable pressure-sensitive adhesive-backed sheet of Calhoun would cover the surface to which it is applied and therefore temporarily “protect” the surface since the sheet would be exposed to the elements instead of the underlying surface.

Whether or not this “protection” is expressly stated or intended by Calhoun is irrelevant.

Likewise, the sheet would obviously be of a material different from that comprising the surface and would therefore temporarily “modify” the surface – such modification being intended or not.

However, the examiner went one step further and provided motivation to use the repositionable pressure-sensitive adhesive-backed sheet of Calhoun to temporarily modify or protect the surface in view of multiple references disclosing repositionable pressure-sensitive adhesive-backed sheets used to temporarily modify a surface in combination with multiple references disclosing pressure-sensitive adhesive backed sheets used to temporarily protect or modify a surface, as set forth in paragraph 9 of the previous office action.

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19. On page 12 of the arguments, Applicant argues that Ochi and Merrill fail to teach or suggest a method to provide temporary surface protection or modification, the method including providing a sheet material having a base portion having physical characteristics of having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05, and providing an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, with separation being caused by stretching of the sheet material.

The examiner points out that Ochi and Merrill both teach a method to provide temporary surface modification, the method comprising providing a sheet material having a base portion and an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, as set forth in paragraph 9 of the previous office action.

The examiner agrees that the references are silent as to the base portion having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05 and separation of the surface elements being caused by this stretching. However, these references were not relied upon for such a teaching. Instead, the references were only used to show that it is known in the art to **temporarily modify a surface** by attaching a **repositionable pressure-sensitive adhesive backed sheet** to the surface, wherein the adhesive has a plurality of elements projecting from its exposed surface such that the elements first contact the surface thereby allowing the sheet material to be correctly positioned before activation of the adhesive, just like the adhesive of Calhoun.

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20. On page 13 of the arguments, Applicant argues that Gochanour and Hibler fail to teach or suggest a method including providing a sheet material having a base portion having physical characteristics of having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05 and providing an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements.

The examiner points out that Gochanour and Hibler were only used to show it being known in the art to **temporarily protect or modify a surface** by attaching a **pressure-sensitive adhesive-backed sheet** to the surface.

21. On page 13 of the arguments, Applicant argues that one skilled in the art would have no motivation to modify Calhoun by combining the teachings of Ochi and Merrill, both of which lack a teaching or suggestion of a sheet material having a base portion that has been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05. Applicant further argues that one skilled in art would have no motivation to modify Calhoun in view of Ochi and Merrill by combining the teachings of Gochanour and Hibler, both of which lack a teaching or suggestion of a plurality of surface elements separated from each other.

First, the examiner would like to point out that Applicant is arguing that the secondary references cannot be used to modify Calhoun merely because each secondary reference does not qualify as 102 prior art against present claim 1 when taken alone. If every secondary reference applied in a 103 obviousness rejection had to qualify as 102 prior art when taken alone, there would be no need to make a 103 rejection in the first place!

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Second, one skilled in the art would have been motivated to use the repositionable pressure-sensitive adhesive-backed sheet of Calhoun to temporarily protect or modify the surface because repositionable pressure-sensitive adhesive-backed sheets for temporary surface modification and pressure-sensitive adhesive backed sheets for temporary surface protection or modification are known in the art, as taught by the collective teachings of Ochi, Merrill, Gochanour, and Hibler, wherein this allows for protection and/or modification of the surface without having to manipulate the surface itself, as set forth in paragraph 9 of the previous office action.

22. On page 13 of the arguments, Applicant argues that one skilled in the art would not modify Calhoun in view of Kaltman because Kaltman fails to teach or suggest the sheet material having a base portion having physical characteristics of having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05 and providing an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, with separation being caused by stretching of the sheet material.

The examiner points out that Kaltman was only used to show that pressure-sensitive adhesive-backed sheets adapted to provide radiation protection are known in the art.

23. On pages 14, 15, and 16, Applicant argues that Gochanour, Hibler, and Kaltman all fail to teach or suggest the sheet material having a base portion having physical characteristics of having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05 and providing an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, with

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separation being caused by stretching of the sheet material and therefore the skilled artisan would not be motivated to modify each of these references in view of Calhoun.

The examiner agrees that Gochanour, Hibler, and Kaltman all fail to teach these limitations. However, one skilled in the art would have been motivated to modify the pressure-sensitive adhesive-backed sheets of each of these references in view of Calhoun, who teaches these limitations, because this allows the sheet material to be correctly positioned on the surface before activating the adhesive to bond the sheet to the surface, as set forth in paragraphs 11, 13, and 16 of the previous office action.

24. On page 15, Applicant argues that one skilled in the art would not modify Calhoun in view of Loewer because Loewer fails to teach or suggest the sheet material having a base portion having physical characteristics of having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05 and providing an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, with separation being caused by stretching of the sheet material.

The examiner points out that Loewer was only used to show it being known in the art to make pressure-sensitive adhesive-backed materials comprising a combination of fluid impermeable and fluid absorbent materials.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi
Patent Examiner
Art Unit 1733



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